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10/755,624	07/06/2004	Kevin Kawakita		5686

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EXAMINER

TURCHEN, JAMES R

ART UNIT	PAPER NUMBER
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2139

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/755,624	Applicant(s) KAWAKITA, KEVIN	
	Examiner James Turchen	Art Unit 2139	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-65 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 29-65 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/06/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 29-65 are pending.

Specification

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The disclosure is objected to because of the following informalities: The Abstract should not reference a figure. The use of trademarks is not allowed within the specification.

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. Claim 29 objected to because of the following informalities: the use of paragraphs and registered trademarks is not allowed in claim language. Appropriate correction is required.

The lengthy claim language is best disclosed in the specification of the application, while the claim language should be clear and concise.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 recites "a specific method of or process" in the first paragraph and it is unclear whether applicant is claiming a method of process or a method or process.

Claim 29 recites "a totally cryptographically secure" in the first paragraph and is rendered indefinite by the term "totally" as nothing in cryptography can be considered totally secure.

Claim 29 recites "safeguarding multi-million dollar digital masters" in the first paragraph and digital masters is not well known in the art and it is unclear what applicant seeks to safeguard.

Claims 29 recites "prior art components integrated into a specific new invention system process of or methods patent" in the first paragraph is indefinite because it is unclear how one would integrate components into a patent. Applicant does not need to state what he/she seeks to patent as it is inherent.

Claim 29 recites "providing of prior art" in the second paragraph and it renders the claim indefinite as it is unclear how "providing of prior art" defines what the method or process of claim 29 is.

Claim 29 recites "brief in length" in the second paragraph and is considered indefinite as it is unclear as to amount of brief.

Claim 29 recites "which can come" in the third paragraph that renders the claim indefinite because it is unclear if the claim language is part of the claimed invention.

Regarding claim 29, the phrase "example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim 29 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a

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manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 37 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. Flow charts or source code listings are not a requirement for adequately disclosing the functions of software.

Applicant is seeking to claim source code, which is considered an abstract idea.

5. Claims 29-65 are replete with similar problems as those listed above. In view of the problems listed above and throughout claims 29-65, the examiner interprets the claimed invention in view of the Abstract as provided by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narin (US 7,185,363).

The abstract of the invention discloses a method or process for a system used to do digital media distribution in an architecture of public key cryptography called the digital media distribution cryptography architecture which is implemented in computer hardware, computer software, and communications protocols, furthermore, the hardware components involved are media ticket smart cards, media ticket smart card readers, local area networks, internet protocol wide area networks, personal computers, world wide web servers, cryptographic media players with built-in media ticket smart card readers, cryptographic digital signal processors, furthermore, the software components involved are cryptographic key distribution programs, cryptographic mathematics algorithms, and cryptographic protocols.

Narin discloses a system and method for securing digital content comprising a smart chip (column 9 lines 50-54), an authentication device (column 9 lines 39-54, device 304 authenticates the user based on the smart card; column 5 line 63-column 6 line 6, device 200 verifies the user's right to the digital content), a playback device (column 5 lines 46-50, device 200), an encrypted content file (column 5 line 63-column 6 line 6, the content is encrypted), and a point-of-sale device (column 9 lines 2-9, kiosk 600). Narin also discloses that device 200 holds a set of personal encryption keys, including a public key and a private key (column 5 lines 44-62, PU-IDENTITY and PR-

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IDENTITY) and the encrypted content file is at least partially encrypted with said public key included in said set of personal encryption keys (column 5 line 63-column 6 line 6). Narin further discloses the playback device (device 200 or device 300) is configured to receive said encrypted content file (column 6 line 57-column 7 line 4, the device 302 (also known as device 200 in figure 2) is connected to device 304; figure 5 step 505, transfer of license and/or content to device 302), decrypts said encrypted content file using said private key (column 5 line 63-column 6 line 6), and plays said content file on said playback device (it is inherent that the content is played once decrypted).

Narin does not disclose said authentication device (device 200 or 302) is configured to hold said smart chip, permit said smart chip to interface with said playback device, detect said authentication device, and electronically communicate with said smart chip, within a predefined communication range. Narin discloses the use of a smart chip for use in authentication as well as authentication of a smart chip (column 9 lines 50-54) and device 302 performs all of the functions of the smart chip as claimed (holds a public/private key pair that allows for decryption of content). Therefore, one of ordinary skill in the art at the time of invention could have used a smart chip to perform the functionality of holding the key pair as well as the license keys for the content. Interfacing a smart chip with a device was well known in the art at the time of invention. It would have been an obvious step for the device 302 and 304 to include a smart chip reader. The player (device 302) would still function as the authentication device (as it would still verify the user's right to the digital content) which interfaces with the smart

chip. It would be obvious to electronically communicate with said smart chip, within a predefined communication range (the smart chip is physically connected).

Conclusion

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US PGPub 20050027991 discloses a method and system of using smart cards with the content keys as well as media distribution.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Turchen whose telephone number is 571-270-1378. The examiner can normally be reached on MTWRF 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571)272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRT


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